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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,803

02/01/2006

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F-8917

7339

28107 7590 05/20/2008

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

05/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,803	Applicant(s) MATSUI, AKIHIDE	
	Examiner Jordan M. Schwartz	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,9,11,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 4,5,10 and 12-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claim 17 is directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth below.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 17 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims directed to the following patentably distinct species: Group I, claims 4-5, 7, 9-16, 18-19 directed to a species of bifocal lens having a first lens member with a protrusion on a convex surface molded from an episulfide resin and comprising a small lens for short-range viewing; and Group II, claim 17, directed to a species of bifocal lens having a bench lens with a convex surface having a first concavity and a small lens being cast and cured over the surface with the concavity. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of

search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Claim Rejections - 35 USC § 112

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed “step with one or two radiused corners” is not supported by the specification or figures as originally filed and therefore presents prohibited new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikata patent number 6,769,768 in view Ono publication number 2004/0188873.

Nishikata discloses the limitations therein including the following: a bifocal plastic lens (abstract); comprising a small lens for short range view (Figures 1 or 2, column 2, line 48, small lens "5"); comprising a preparatory lens member having the small lens protruding on a convex surface side (Figures 1 or 2, column 2, lines 48-55, lens matrix "3" as the preparatory lens); the preparatory lens molded from a resin material (column 2, lines 18 and 59-65, the preparatory lens molded from polyurethane); and another resin adhered to the surface of the small lens and preparatory lens to be integrated with the preparatory lens (Figures 1 or 2, column 2, lines 59-65, coating material "8"); the other resin having a lower refractive index compared with the preparatory lens (abstract); the small lens incorporated into the resulting bifocal lens (Figures 1-2); the small lens does not cause a protrusion to form on any external surface of the resulting bifocal lens (Figures 1 or 2); and a concave surface side of the preparatory lens member as a surface having corrective power (column 1, line 50 to column 2, line 17, column 3, line 41 to column 4, line 20). Nishikata discloses as is set forth above but discloses the material "8" applied to the preparatory lens matrix "3" by coating (column

2, lines 59-64) and not by casting and curing as claimed. However, the examiner takes Judicial Notice that casting and curing are a well known alternative method to coating of applying an outer layer to a lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the outer layer "8" of Nishikata as being applied by casting and curing since Nishikata discloses the outer layer being applied by coating and since casting and curing are a well known alternative method to coating of applying an outer layer to a lens surface for the purpose of providing an outer layer in a more controlled manner and of a more uniform thickness.

Nishikata discloses as is set forth above including disclosing an inner first resin material that provides the majority of the optical correction with an outer second resin material of lower refractive index formed on a convex surface thereof to provide protection for the lens (see above and Figures 1-2 and column 2, lines 18-28) but does not specifically disclose the inner resin material of episulfide resin. Ono teaches that in forming ophthalmic lenses having an inner first resin material that provides the majority of the optical correction and second resin material having a lower index of refraction and which provides lens protection, that it is desirable to have the inner first resin material formed of an episulfide resin adhered to an outer compatible resin material of a lower refractive index, which outer resin material provides lens protection for the purpose of providing an ophthalmic lens that has both a high refractivity and increased durability (Figure 1, abstract, paragraph 0005, 0011, 0013, 0016). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the invention was made to have the inner resin material of Nishikata as an episulfide resin material adhered to a compatible outer resin material since Ono teaches that in forming ophthalmic lenses having an inner first resin material that provides the majority of the optical correction and second resin material having a lower index of refraction and which provides lens protection, that it is desirable to have the inner first resin material formed of an episulfide resin adhered to an outer compatible resin material of a lower refractive index, which outer resin material provides lens protection for the purpose of providing an ophthalmic lens that has both a high refractivity and increased durability.

As stated above, the examiner takes Judicial Notice of the casting and curing to apply an outer layer to a lens surface. Regardless, Ono teaches that in adhering the first resin layer being formed of an episulfide resin to the second compatible resin material that it is desirable to adhere the resins by casting and curing for the purpose of providing an improved means of attaching the resin material to each other (paragraphs 0002, 0005). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a first resin material of episulfide resin attached to a second compatible resin material by casting and curing since Ono further teaches this as an improved means of attaching the resinous materials to each other.

With respect to claim 9, Nishikata and Ono disclose and teach as is set forth above and Ono further teaches that the outer resinous material can be dyed for the purpose of providing tinted eyeglasses (paragraphs 0011, 0030, 0060). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to have the outer resinous material of the lens of Nishikata as modified by Ono as being dyed since Ono further teaches that the outer resinous material can be dyed for the purpose of providing tinted eyeglasses.

With respect to claim 18, Nishikata and Ono disclose and teach as set forth above including disclosing the lenses being used for eyeglasses (Nishikata, abstract and Ono, paragraph 0060) and Ono further teaches that the lens may be ground for the purpose of providing a finished ophthalmic lens (paragraphs 0008, 0060). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the inner concave surface of the lens of Nishikata as modified by Ono as having the inner concave surface ground since Ono further teaches that the lens may be ground for the purpose of providing a finished ophthalmic lens. Regardless, the examiner further takes Judicial Notice that the grinding of ophthalmic lenses is well known in the art of ophthalmic lenses and a means of finishing the lenses and providing the desired optical correction. Therefore, it further would have been obvious to one of ordinary skill in the art at the time the invention was made to have the inner surface of the lens of Nishikata as modified by Ono as being ground to adjust the corrective power since the grinding of ophthalmic lenses is well known in the art of ophthalmic lenses and a means of finishing the lenses and providing the desired optical correction.

In reference to claim 19, Nishikata and Ono disclose and teach as set forth above and Nishikata further teaches that the difference between the indices of refraction of the resinous materials should be greater than 0.143 for the purpose of providing the lens with improved optical qualities (paragraphs 0005, 0011, 0013-0016). Therefore, it

would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens of Nishikata as modified by Ono as having a difference between the indices of refraction of the resinous materials as greater than or equal to 0.143 since Ono further teaches of this feature for the purpose of providing the lens of improved optical qualities.

Allowable Subject Matter

Claims 4-5, 10, 12-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 4-5 and 14-16, none of the prior art either alone or in combination disclose or teach of the claimed bifocal plastic lens specifically including, as the distinguishing feature in combination with the other limitations, at least part of the interface between the convex surface and the preparatory lens by a peripheral edge portion of the small lens being chamfered with a curved surface having a curvature lower than the curvature by portions of the small lens other than the peripheral edge portion in order to prevent the edge of the small lens from being conspicuous. Specifically, with reference to claims 10 and 12-13, none of the prior art either alone or in combination disclose or teach of the claimed bifocal plastic lens specifically including, as the distinguishing feature in combination with the other

limitations, a step located as claimed within claim 10, the small lens being truncated thereby forming a truncated edge, with the step comprising a material having a refractive index such that a light ray incident on the step is reflected and the curvature of the step is less than the curvature of the small lens.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Comments

For applicant's information, the amended abstract received March 3, 2008 is in compliance with the requirements of the MPEP.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jordan M. Schwartz
Primary Examiner
Art Unit 2873
May 15, 2008

/Jordan M. Schwartz/
Primary Examiner, Art Unit 2873

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